

REMARKS/ARGUMENTS

Claims 1, 3 to 5, 7 to 10, 12 to 16 and 19 to 25 remain in this application. Claims 2, 6, 11, 17 and 18 have been cancelled, without prejudice, to presenting in a continuing application.

The Examiner has noted that a certified copy of the German priority application has not been filed and that the declaration is defective. Applicants are obtaining the certified copy and will submit it in due course. A Supplemental Application Data Sheet is enclosed herewith, which corrects the defective declaration.

Claim 1 has been amended to include the limitations of original claims 6, 11, 17 and 18. Claim 5 has been amended to return it to its original dependent form. Claim 9 has been rewritten in independent form. Claim 24 has been amended to include the limitation of original claim 9, requiring the substance capable of migration to comprise at least two wax-like substances.

Claims 1, 15, 22 and 24 have been amended to correct the basis of the weight percent of the substance capable of migration and particulate material. Support for these changes is found in original claims 11, 15 and 22.

Claims 1, 3 to 5, 7 to 12, 14, 15 and 24 have been rejected as being anticipated by Kupits US Patent No. 3,129,194 (Kupits). Since claim 1 has been amended to include the limitations of claims 17 and 18, claim 1 is no longer anticipated by Kupits.

Claims 17 and 18 were rejected as being obvious over Kupits in view of Dees et al. US Patent No. 4,816,319 (Dees). The examiner has taken the position that Dees teaches it is old and well-known in the art to have a PVC floor covering having a profile with elevations and recesses for the purpose of producing a resilient floor covering with

increased wear and slip resistance, and therefore it would be obvious to modify Kupits to have a profile with elevations and recesses as suggested by Dees.

Further, the Examiner states, in the carryover paragraph on pages 5 and 6 of the Office Action, that “it would have been obvious to one of ordinary skill in the art at the time the applicant’s invention was made to have modified the profile of elevation and recesses in Dees et al. to where the average spacing between profile peaks in the centerline is more than about 200 μm and less than about 1000 μm and the difference in height between the elevations and the recesses is from about 20 μm to about 200 μm , since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art in the absence of showing unexpected results. *MPEP 2144.05(II)*.”

However, since the purpose of forming the elevations and recesses in Dees (for its decorative lenticular effect, and wear and slip resistance) is different than the purpose of the presently claimed elevations and recesses (to improve soiling behavior in combination with the substance capable of migration), optimizing the elevations and recesses of Dees would not necessarily yield the presently claimed ranges of spacing and height. In fact, there is no teaching or suggestion in Dees regarding spacing between the peaks. Therefore, there can be no motivation to optimize an undisclosed characteristic.

As held by the Court of Appeals for the Federal Circuit, in *In re Fritch*, 972 F2d 1260, 1266, 23 USPQ 2d 1780 (1992):

“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so.” [FN 13] Although couched in terms of combining teaching

found in the prior art, the same inquiry must be carried out in the context of a purported obvious 'modification' of the prior art. ...

FN 13. *ACS Hosp. Systems, Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed.Cir. 1984)"

(Emphasis in original.) Since there is no teaching or suggestion of any criticality of peak spacing, there is no suggestion to modify or optimize such peak spacing. Consequently, there is no *prima facie* obviousness rejection of claims 17 and 18 over the combination of Kupits and Dees. Therefore, amended claim 1 and claims 3 to 5, 7, 8, 10, 12 to 16 and 19 to 23, dependent thereon are allowable.

Claim 24 has been amended to include the limitation of original claim 9. Claims 9 and 24 require the substance capable of migration to comprise at least two wax-like substances having different melting points. The Examiner has rejected claim 9 as being anticipated by Kupits. The Examiner takes the position that Kupits teaches "the wax-like substance comprises a plurality of wax-like substances having different melting points," citing column 5, line 44, to column 6, line 10. The Examiner is in error. At column 5, lines 38 to 47, Kupits states:

"It is essential in carrying out the method of producing surface coverings in accordance with the invention that the composition used in making the granules contain a small amount of a release additive. Release additives in accordance with the invention are waxy substances which have a softening pint of below 330° F. are satisfactory when compositions comprising the preferred resinous binders are utilized in accordance with the invention."

(Emphasis supplied.) The specification continues by disclosing acceptable release additives. Therefore, while numerous different release additives are listed, there is no suggestion of using two of the release additives, particularly two release additives having different melting points, simultaneously. If the Examiner disagrees, she is respectfully

requested to point out specifically where in Kupits there is such a suggestion. Absent such a suggestion, independent claims 9 and 24, and claim 25 dependent thereon, are allowable over Kupits.

Therefore, all of the rejections have been met and Attorney for Applicants submits that the present claims are in a condition for allowance. Therefore, early consideration and allowance are respectfully requested.

Respectfully submitted,

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Date

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